

## **REMARKS**

Applicant has amended the claims to remove extraneous reference numerals that were not caught in the preliminary amendment filed with this application and to recite elements and relative orientations of elements of the claimed prosthesis necessary to recite the invention in its proper context. No new matter has been added by these amendments.

Claims 1-3 and 5-7 stand rejected as anticipated by Bohn. The Examiner reads Bohn as disclosing a hip prosthesis comprising a shaft with projecting fins on front and rear faces 52, 48, in which each of the fins has a steep medial flank that is inclined toward the femoral neck. The Examiner reads Figs. 2 and 5 of Bohn as disclosing an angling of the fins 5-15 degrees relative to the shaft. The Examiner concludes that the fin is angled and tapers toward the bottom of the prosthesis and that the prosthesis end 24 anchors within the diaphysis. This rejection and its supporting reasoning are respectfully traversed.

The Examiner's reading of Bohn does not address all of the limitations of independent claim 1. To make out an anticipation rejection, as set forth in MPEP 2131: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” [Citation omitted.] \* \* \* ‘The identical invention must be shown in as complete detail as is contained in the ... claim.’ [Citation omitted.] \* \* \* The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. [Citation omitted.]” Bohn fails to disclose the invention as required for it to support an anticipation rejection.

Bohn does not disclose that either (a) the “medial flank \* \* \* deviates away from a direction of a longitudinal axis of the shaft” or (b) “the height of the fins decreas[es] in a lateral direction from an edge delimiting the steep flank.” Applicant respectfully suggests that since the Examiner is correct in identifying Bohn’s lobes 48, 52 as corresponding to the claimed fins, considering the medial direction as being defined relative to the position of the prosthesis when implanted in the femur so that the femoral neck extends medially, FIG. 6 contradicts the

Examiner's reading of Bohn. As can be seen from FIG. 6 of Bohn, the medial flanks of the projecting fins 48, 52 are parallel to, and do not deviate from, the direction of the longitudinal axis of the shaft, as required by the geometry evident from FIG. 5, which is a view of Bohn's prosthesis taken at a 90° angle to the orientation of the medial flanks shown in FIG. 6.

Applicant further notes from FIG. 7 of Bohn that the height of fins 48, 52 increases when one proceeds from the medial side of Bohn's prosthesis to the lateral side. Bohn has clearly marked the lateral and medial sides of the prosthesis on FIG. 7, so there can be no doubt that Bohn discloses the opposite of what applicant claims in independent claim 1.

The rejection of claims 1-3 and 5-7 as anticipated by Bohn should therefore be withdrawn.

Claims 4 and 8 stand rejected under 35 USC 103(a) on Bohn alone. The Examiner takes the position that all one has to do to arrive at the inventions of claims 4 and 8 is to rotate the fins on Bohn's implant. This rejection and its supporting reasoning are respectfully traversed.

First, since, as explained above, Bohn does not provide the disclosures for which it is cited in support of the rejection, this rejection should be withdrawn. Rotating Bohn's fins does not produce the invention of claims 4 and 8. Second, the Examiner has not provided any reason why any person of ordinary skill in the art *would* have rotated Bohn's fins as suggested in the Action. Bohn is entirely devoid of any such reason, as it seems to be quite satisfied with the structure it discloses.

The rejection of claims 4 and 8 under 35 USC 103(a) on Bohn alone should therefore be withdrawn.

Early action allowing claims 1-8 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge

the cost of such petitions and/or other fees due in connection with the filing of this document to  
**Deposit Account No. 03-1952** referencing docket no. 246472007600.

Respectfully submitted,

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